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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
BOUCHARD, et al.

Examiner: CRIARES

Art Unit: 1617

Application No.: 09/903,092

Filed: July 11, 2001

Title: **NOVEL POLYHYDROXYPYRAZINE
DERIVATIVES, THEIR PREPARATION AND
THE PHARMACEUTICAL COMPOSITIONS
WHICH COMPRISE THEM**

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Signature: *Benito M. Dima*

Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO THE RESTRICTION REQUIREMENT

This paper is in response to the Restriction Requirement (Paper no. 5) mailed October 2, 2002, restriction was alleged to be required pursuant to 35 U.S.C. § 121. Applicants also file concurrently herewith a Petition under 37 C.F.R. § 1.136(a) to extend the time for response for four (4) months, or until March 2, 2003.

I. Status of Claims

Claims 1-14 are pending in the instant application.

II. Discussion of Restriction Requirement pursuant to 35 U.S.C. § 121

The Examiner's alleged basis for requiring the Restriction Requirement is that

- I. Claims 1-12, 13 and 14 drawn to organic compounds; and
 - II. Claim 11, drawn to a process for preparing organic compounds.
- Inventions of Group I and II are related as **process and apparatus** (organic compounds) for its practice. The inventions are distinct if it can be shown that either: (1) the **process as claimed can be practiced by another materially different apparatus or by hand**, or (2) the **apparatus as claimed can be used to practice another and materially different process**. (MPEP § 806.05(e)). In this case the compounds of Group I can be used to treat a variety of medical diseases.

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Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Further restriction may be required.

Paper No. 5 at page 2; emphasis added.

Applicants respectfully traverse the Restriction Requirement. Applicants submit that the Restriction Requirement is grossly in error relative to the basis alleged. First, applicants submit that MPEP § 806.05(e) is incorrectly applied as authority for the Restriction Requirement. MPEP § 806.05(e) would only be applicable where process and apparatus claims are being claimed. In the instant case no apparatus claims are being claimed; and Examiner's allegation of equivalency of apparatus to organic compounds, i.e., "apparatus (organic compounds)", is without scientific merit. Furthermore, as the present case does claim process (11-12) and compound/composition (1-10 and 13) claims¹ such would only be correctly subject to a Restriction Requirement pursuant to MPEP § 806.05(f). Lastly, the Examiner's statement that the "compounds of Group I can be used to treat a variety of medical diseases" is of no moment regarding the factors permissible for making a Restriction Requirement pursuant to MPEP § 806.05(f). Thus, the present Restriction Requirement pursuant to MPEP § 806.05(e) or MPEP § 806.05(f) is without support. In view of the aforesaid, Applicants request the withdrawal of the Restriction Requirement until a supportable basis is proffered pursuant to the correct authority for such.

III. Provisional Election


To comply with the Examiner's Restriction requirement, Applicants provisionally elect, with traverse, Group I. Claims 1-10 and 13 are readable on Group I.

Furthermore, Applicants affirm their right to file one or more divisional applications with respect to any of the non-elected subject matter.

Respectfully submitted,

February 24, 2003

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¹ Applicants note also that the present case also claims to a method of use of the compound

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